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EXAMINER	
BOSWELL, BETH V	
ART UNIT	**PAPER NUMBER**
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Please find below and/or attached an Office communication concerning this application or proceeding.

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SHAHID MUJTABA, CIPRIANO A. SANTOS,
DIRK M. BEYER, and ALEX XIN ZANG

Appeal 2009-009723
Application 10/023,960
Technology Center 3600

Before, ANTON W. FETTING, JOSEPH A. FISCHETTI and
BIBHU R. MOHANTY, *Administrative Patent Judges*.

FISCHETTI, *Administrative Patent Judge*.

DECISION ON APPEAL

The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the "MAIL DATE" (paper delivery mode) or the "NOTIFICATION DATE" (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

STATEMENT OF THE CASE

Appellants seek our review under 35 U.S.C. § 134 of the Examiner's final rejection of claims 1-2, 5-17, 20-26 and 29-35. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF DECISION

We AFFIRM.

THE INVENTION

Appellants claim a system and method for an optimal integrated action plan for procurement, manufacturing, and marketing. (Specification 1: 7-9).

Claim 25, reproduced below, is representative of the subject matter on appeal.

> 25. A computer-usable medium having computer-readable program code embodied therein for causing a computer system to perform a method for defining an optimal end of product life integrated action plan for procurement, manufacturing, and marketing comprising:
> a) accessing end of product life materials planning parameters;
>
> b) accessing end of product life pricing parameters; and
>
> c) evaluating said end of product life materials planning parameters and said end of product life pricing parameters in conjunction to define said integrated action plan, wherein said integrated

action plan is an end of product life integrated action plan.

DISPOSITION OF THE APPEAL

The Examiner entered a new ground of rejection in the Examiner's Answer against claims 1-2, 5-11 under 35 U.S.C. § 101 as being directed to nonstatutory subject matter. (Ans. 3-4). The Examiner properly gave notice of the new ground of rejection (Ans. 3) and the Technology Center Director approved it (Ans. 14). As the Answer indicated, the Appellants were required to respond to the new ground within two months in either of two ways: 1) reopen prosecution (*see* 37 C.F.R. § 41.39(a)(2)(b)(1)); or 2) maintain the appeal by filing a reply brief as set forth in 37 C.F.R. § 41.41 (*see* 37 CFR 41.39(a)(2)(b)(2)), "to avoid *sua sponte* dismissal of the appeal as to the claims subject to the new ground of rejection." (Ans. 13-14). According to the record before us, neither option appears to have been exercised.

Accordingly, the appeal as to claims 1-2, 5-11 subject to the new ground of rejection under § 101 as being directed to nonstatutory subject matter stands dismissed.

Upon return of the application to the Examiner, the Examiner should:

(1) cancel claims 1-2, 5-11 subject to the new ground of rejection and;

(2) notify the Appellants that the appeal as to claims 1-2, 5-11, subject to the new ground of rejection under §101, as being directed to nonstatutory subject matter, is dismissed and claims 1-2, 5-11 are

cancelled. *See* Manual of Patent Examining Procedure (MPEP) § 1207.03, 8th ed., Rev. 7, Jul. 2008.

Given that the appeal as to claims 1-2, 5-11 stands dismissed, the rejection before us for review is reduced to as follows:

THE REJECTION

The Examiner relies upon the following as evidence of unpatentability:

Huang	US 6, 151, 582	Nov. 21, 2000

Zussman, Eyal, "Planning of Disassembly Systems", Assemble Automation, 1995

The following rejection is before us for review.

The Examiner rejected claims 12-17, 20-26 and 29-35 under 35 USC 103(a) as being unpatentable over Huang in view of Zussman.

ISSUE

Did the Examiner err in rejecting claims 12-17, 20-26 and 29-35 on appeal as being unpatentable under 35 U.S.C. § 103(a) over Huang in view of Zussman on the grounds that a person with ordinary skill in the art would understand that Zussman in addressing levels of planning in a recycling network covering manufacturers and consumers and causing relationships to be established therebetween, discloses an end of product life integrated action plan?

FINDINGS OF FACT

We find the following facts by a preponderance of the evidence:

1. We adopt the Examiner findings as set forth in the Answer on pages 4-9.

2. Zussman addresses two levels of planning: one of which levels is a recycling network which includes manufacturers and consumers. (Page 20).

3. Zussman discloses that "[m]anufacturers must establish co-operative relationships with the suppliers, the consumers as well as the recyclers in order to manage the materials' flow in an environmentally sound way." (Page 20).

ANALYSIS

We affirm the rejection of claims 12-17, 20-26 and 29-35.

Initially, we note that the Appellants argue independent claims 12 and 25 together as a group. (Appeal Br. 8). Correspondingly, we select representative claim 25 to decide the appeal of these claims, remaining claim 12 falling with claim 25.

Appellants argue that "the end of product life integrated action plan is clearly recited in the Claim preamble and throughout the specification as "an end of product life integrated action plan for procurement, manufacturing, and marketing" (emphasis added). (Appeal Br. 9).

We hold differently. The preamble phrase, *an optimal end of product life integrated action plan for procurement, manufacturing, and marketing,* is not sufficiently incorporated into the body of the claims to constitute a positive limitation for *procurement, manufacturing, and marketing.*

Although the preamble recitation for "*product life integrated action plan*" is found in the body of the claim, the term "*for* procurement, manufacturing, and marketing" is not. We thus read the phrase "*for procurement, manufacturing, and marketing*" as an intended use limitation, and not as a positive limitation.

Appellants next assert that Zusssman "...would not be a proper basis for the suggested combination since there is no teaching toward end of product life integrated action plan for procurement, manufacturing, and marketing. (Appeal Br. 9).

We disagree with Appellants. First, for the reasons discussed *supra*, we will not consider the phrase *for* procurement, manufacturing, and marketing, a positive limitation of claim 25. Thus, Appellants' argument to the deficiency of Zussman as to these features is not persuasive on its face. However, even if such elements were positively recited, the words procurement, manufacturing, and marketing are so broadly worded within the context of the independent claims as to be met by Zussman. That is, Zussman addresses two levels of planning, one of which is the recycling network comprising the manufacturers and consumers (FF 2). Additionally, Zussman discloses marketing via establishing co-operative relationships with the suppliers, the consumers as well as the recyclers in order to manage the materials' flow in an environmentally sound way. (FF 3). Thus, we find that Zussman even within the confines of a disassembly system, discloses: i) procurement, i.e., the environmentally sound flow of material from suppliers and consumers, ii) manufacturing incorporated with planning (FF 2), and iii)

marketing by relationship building between suppliers, the consumers and recyclers.

Appellants also argue that the combination of Haung and Zussman is improper because the references teach away from each other in that "the two concepts, e.g., manufacturing and disassembling, could not be more contradictory or conflicting." (Appeal Br. 11). We disagree with Appellants because an aspect of manufacturing is the proper disposal of by-products left by the manufacturing process. Such by-products could be disposed of in the manner proposed by Zussman, and thus Zussman does not actually teach away from *every aspect* of *all* manufacturing facets. *See In re Gurley*, 27 F.3d 551, 553 (Fed. Cir. 1994).

CONCLUSIONS OF LAW

We conclude the Examiner did not err in rejecting claims 12-17, 20-26 and 29-35 under 35 U.S.C. 103(a) as being unpatentable over Huang in view of Zussman.

DECISION

1. The decision of the Examiner to reject claims 12-17, 20-26 and 29-35 is AFFIRMED.

2. Upon return of the application to the Examiner, the Examiner should:

(1) cancel claims 1, 2 and 5-11 subject to the new ground of rejection and;

(2) notify the Appellant that the appeal as to claims 1,2 and 5-11, subject to the new ground of rejection under § 101, as being directed to nonstatutory subject matter, is dismissed and claims 1,2 and 5-11 are cancelled. *See* Manual of Patent Examining Procedure (MPEP) § 1207.03, 8th ed., Rev. 7, Jul. 2008.

AFFIRMED

MP

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